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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,071	01/23/2004	Toros Kejejian		8003

7590
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 New York, NY 10017

04/04/2007

EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/764,071	Applicant(s) KEJEJIAN, TOROS	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS NON-FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 1/22/2007.

- Claims 1-20 were canceled.
- Claims 21-40 are pending.

Priority

[1] The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 29/179069, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In the instant case, changing the priority from a continuation application to a continuation in part application will remedy said deficiency.

Claim Objections

[2] Claim(s) 21, 23, 30, and 35 were previously objected to because of informalities. Applicant has failed to successfully address these issues in the amendment filed on 1/22/2007. Accordingly, the objection(s) to the claim(s) 21, 23, 30, and 35 have not been withdrawn (see office action dated (8/25/2006)).

Claim Rejections - 35 USC § 102

[3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claim 21 is rejected under 35 U.S.C. 102(e(1)) as being unpatentable over Abaev, US-D499, 981, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Abaev is identical in all material respects to that of the claimed design, *Hupp v. Siroflec of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Abaev teaches of a mixed cut gemstone comprising:

a crown;

a pavilion (see figure below);

four lower corner facets (1), said lower corner facets being triangles (1);

two long-side lower girdle facets (2), said long-side lower girdle facets being triangles or trapezoids (2);

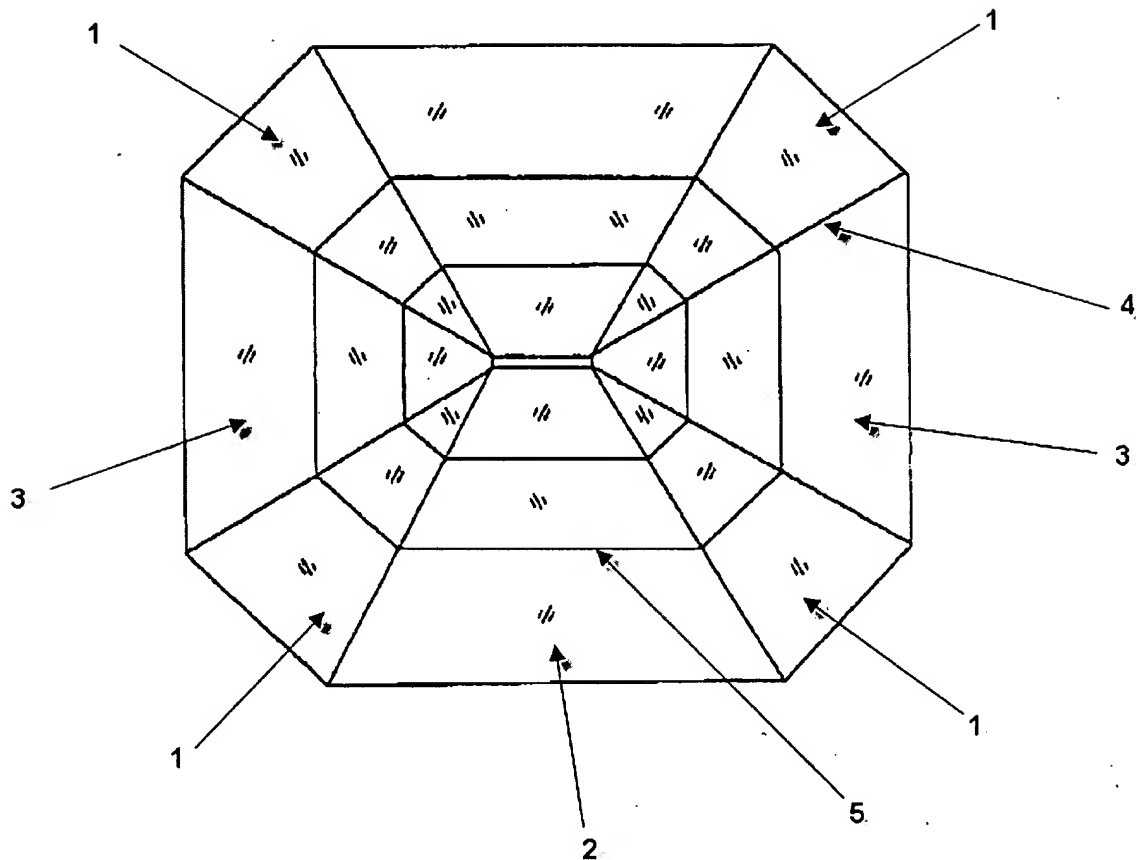
two short-side lower girdle facets (3), said short-side lower girdle facets being triangles (3);

a plurality of step cuts (5), said step cuts being substantially equal in width; and

a plurality of rib lines (4);

whereby said steps cuts (5) are cut at a predetermined angle with respect to said lower girdle facets (2,3) with each step (5) being at a slightly different angle, said different angle step cuts (5) [allowing light that passes through the crown to hit the plurality of steps cuts at different angles thereby bending the light several times in different directions thus providing the gemstone with parallel incoming and outgoing rays of light that make the gemstone appear more brilliant and scintillated].

Examiner's note: the above statement in brackets is an example of intended use. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. In the instant case, the above amendment to the claim has provided no additional structure requirements or limitations. Attempting to claim a gemstone via the way light passes through said gemstone is not proper and is not given any patentable weight over the prior art that satisfies the same structural limitations.



Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abaev, US-D499, 981, in view of Kejejian US-6,449,985.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 22, Abaev teaches of that from Claim 21.

The difference between the claim and Abaev is that the claim recites:

four upper corner facets, said upper corner facets being polygons;
two long-side upper girdle facets, said long-side girdle facets being triangles;
two-short side upper girdle facets, said short-side upper girdle facets being triangles; and
four break table lines, said break table lines separating said table from said upper corner facets;

[whereby said break table lines provide the gemstone with better dispersion and scintillation coefficients].

Kejejian discloses a mixed cut gemstone similar to that of Abaev. In addition, Kejejian further teaches a

a girdle (51);

a table (13);

four upper corner facets (15), said upper corner facets being polygons (15);

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two long-side upper girdle facets (17), said long-side girdle facets being triangles (17);
two-short side upper girdle facets (17), said short-side upper girdle facets being triangles (17); and

four break table lines, said break table lines separating said table (13) from said upper corner facets (15);

[whereby said break table lines provide the gemstone with better dispersion and scintillation coefficients].

[]: Example of intended use as the statement fails to further limit the structure of the claimed invention. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

It would have been obvious to one of ordinary skill in the art, having the disclosures of Abaev and Kejejian before him at the time the invention was made, to modify the crown and table of Abaev to incorporate an embodiment (with obvious sizes changes to accompany the different size pavilion, as in Kejejian). One would have been motivated to make such a combination because one would want to achieve that crown and table structure, as taught by Kejejian to go along with the pavilion structure from Abaev.

Re: Claim 23, Kejejian (Claim 1).

Re: Claim 24, Kejejian discloses wherein the table (13) is flat.

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Re: Claim 25, Abaev teaches wherein said lower corner facets have an inclination of approximately 40 to 50 degrees with respect to a plane of said girdle (the figures of the pavilion between the applicant and Abaev are identical).

Re: Claim 26, Abaev teaches wherein said lower corner facets (1) are isosceles triangles (1).

Re: Claim 27, Kejejian (Claim 5).

Re: Claim 28, Kejejian (Claim 6).

Re: Claim 29, Kejejian (Claim 11).

Re: Claim 30, Kejejian (Claim 12).

Re: Claim 31, Abaev teaches wherein said rib lines divide said pavilion into eight sides.

Re: Claim 32, Abaev teaches wherein said rib lines run from said girdle's eight sided shape to a culet line.

Re: Claim 33, Abaev teaches wherein said rib lines converge at a culet point.

Re: Claim 34, Kejejian discloses wherein said table is slightly elevated from the surface of a girdle plane.

Re: Claim 35, Kejejian (Claim 12).

Re: Claim 36, Kejejian (Claim 11).

Re: Claim 37, Abaev teaches wherein said pavilion has a depth of approximately one fourth of a length of said girdle (the figures of the pavilion between the applicant and Abaev are identical).

[7] Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abaev, US-D499, 981, in view of Kejejian US-6,449,985, and further in view of Grossbard, US -4,555,916.

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Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 38, Abaev in view of Kejejian teaches of claim 22.

The difference between the claim and Abaev in view of Kejejian is the claim recites: further comprising a plurality of crown facets. Grossbard discloses a mixed cut gemstone similar to that of Abaev in view of Kejejian. In addition, Grossbard further teaches of a plurality of crown facets (19). It would have been obvious to one of ordinary skill in the art, having the disclosures of Abaev in view of Kejejian and Grossbard before him at the time the invention was made, to modify the crown of Abaev in view of Kejejian to include facets as in Grossbard. One would have been motivated to make such a combination because one would want to achieve that exact crown facet structure, as taught by Grossbard.

Response to Arguments

[8] Applicant's amendment, see amendment and remarks filed 1/22/2007, with respect to the rejection(s) of claim(s) under Namdar, US-D499,981, have been fully considered. Due to the priority behind the applicant's design application, the rejection with regard to Namdar has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Abaev, US-D499, 981. Please also note the additional notice of reference cited.

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Conclusion

[9] THIS ACTION IS NON-FINAL

[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

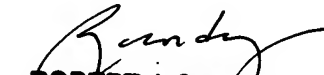
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR


3/28/07

David Reese
Assistant Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER